

TTAB

Lynn G. Foster (1105)  
LYNN G. FOSTER, L.C.  
602 East 300 South  
Salt Lake City, UT 84102  
Telephone: (801) 364-5633  
Facsimile: (801) 355-8938

---

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
TRADEMARK TRIAL AND APPEAL BOARD

---

TPK Pharmaceutical, L.L.C.,

Petitioner,

vs.

Clientele, Inc.,

Respondent.

Cancellation No. 92042537

---

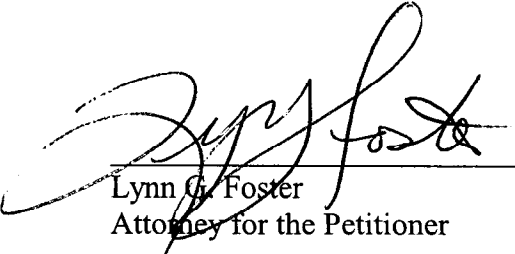
PETITIONER'S MOTION FOR SUMMARY JUDGMENT AND TO STAY DISCOVERY

Mail Stop TTAB- No Fee  
Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3513

The Petitioner moves the Trademark Trial and Appeal Board (TTAB) for summary judgment declaring Reg. No. 2,740,269 cancelled because there is no material issue of fact and that as a matter of law that there is likelihood of confusion and the Petitioner conclusively has priority over the Registrant.

During the pendency of this Motion, the Petitioner moves the TTAB for an order staying discovery.

DATED this 11<sup>th</sup> day of August, 2004.

  
\_\_\_\_\_  
Lynn G. Foster  
Attorney for the Petitioner



08-16-2004

U.S. Patent & TMO/TM Mail Rpt Dt. #22

Lynn G. Foster (1105)  
LYNN G. FOSTER L.C.  
602 East 300 South  
Salt Lake City, UT 84102  
Telephone: (801) 364-5633  
Facsimile: (801) 355-8938



08-16-2004

U.S. Patent & TMO/c/TM Mail Rpt Dt. #22

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

TPK Pharmaceutical , L.L.C.,

Petitioner,

vs.

Clientele, Inc.,

Respondent.

Cancellation No: 92042537

**MEMORANDUM IN SUPPORT  
OF PETITIONER'S MOTION FOR  
SUMMARY JUDGMENT AND TO STAY DISCOVERY**

Trademark Trial and Appeal Board  
Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3513

## I. INTRODUCTION

The present matter relates to a dispute between Petitioner, TPK Pharmaceuticals, L.L.C. and Registrant, Clientele, Inc. concerning cancellation of U.S. Trademark Reg. No. 2,740,269.

Because the Petitioner has priority in its use of SLIM FACTOR over Registrant's use of SLIMMING FACTORS, both for a nutritional product, Reg. No. 2,740,269 must be cancelled.

## II. STATEMENT OF UNDISPUTED FACTS

The pertinent undisputed facts respecting this Motion of TPK for Summary Judgment are set forth below:

1. The Petitioner, TPK Pharmaceuticals, L.L.C. (TPK and Petitioner), and ITG, Inc. (ITG) are related companies in the field of nutritional and dietary supplements. IMMUNE TREE is a house mark of ITG registered in the United States Patent and Trademark Office (Reg. No. 2,415,620). ¶3 and Exhibit "A," Kleinsmith Decl.
2. One of the supplements is called SLIM FACTORS. A copy of a label attached to containers of the goods. ¶ 5 and Exhibit "B," Kleinsmith Decl.
3. Relevant SLIM FACTORS literature is attached as Exhibit "C," Kleinsmith Decl.
4. The mark SLIM FACTORS was first used on the nutrition product on March 26, 2002 (Exhibit "D," Kleinsmith Decl.) and has been continuously used thereafter (Exhibit "E," Kleinsmith Decl.). Representative invoices are attached as Exhibit "F," Kleinsmith Decl.
5. On February 19, 2003, the Petitioner filed U.S. Trademark Application Serial No. 76/492,358 for registration of SLIM FACTORS based upon Petitioner's first date of use, i.e. March 26, 2002. ¶ 8 and Exhibit "G," Kleinsmith Decl.

6. Based upon a use date of May 12, 2002, the Registrant, Clientele, Inc., filed U.S. Trademark Application Serial No. 76/459,995 on October 21, 2002, for SLIMMING FACTORS which matured into U.S. Reg. No. 2,740,269. ¶ 9 and Exhibit “H,” Kleinsmith Decl.

7. The Petitioner has priority in its use date (March 26, 2002) over the use date May 12, 2002 of the Registrant. Therefore, Reg. No. 2,740,269 should be cancelled. ¶ 10, Kleinsmith Decl.

8. In the course of discovery, the Registrant has failed to provide any evidence of a use date by the Registrant earlier than May 12, 2002, for SLIMMING FACTOR on the Registrant’s nutritional goods in the ordinary course of Registrant’s business and trade. ¶ 11, Kleinsmith Decl.

9. In Petitioner’s pending Trademark Application Serial No. 76/495,358 for SLIM FACTORS, the Examining Attorney has held there is a likelihood of public confusion between SLIMMING FACTORS and SLIM FACTORS. ¶ 12 and Exhibit “I,” Kleinsmith Decl.

10. The Registrant does not challenge the determination of the Examining Attorney that there is a likelihood of public confusion. ¶ 13 and Exhibit “J,” Kleinsmith Decl.

### III. THE ISSUES

The issues to be ruled upon in respect to this Motion for Summary Judgment are: (1) does the Petitioner have priority of use and, if so, (2) is there a likelihood of confusion between the earlier used mark SLIM FACTORS and the later used mark SLIMMING FACTORS, both for the same goods, i.e. dietary supplements.

#### IV. ARGUMENT

##### A. Motions for Summary Judgment are Favored

As a matter of public policy, cases without merit, as here, should be disposed of by Summary Judgment, to, among other things, conserve the time of the TTAB and the resources of the parties.

The Rule 56 (Fed.R.Civ.P.) standard is two fold, i.e., based on the evidence before the TTAB, there is no issue of material fact and, as a matter of law, the movant is entitled to prevail.

##### B. Likelihood of Confusion is Conceded by Registrant

The Examining Attorney in the SLIM FACTORS Application has found a likelihood of public confusion between SLIMMING FACTORS and SLIM FACTORS for dietary supplements, and the Registrant does not take issue with the ruling of the Examining Attorney. Exhibits "I" and "J," Kleinsmith Decl.

##### C. The Petitioner has Priority

The Petitioner's first date of use in commerce of SLIM FACTORS, in a commercial context, on a nutritional product was March 26, 2002. ¶ 7 and Exhibit "F," Kleinsmith Decl.

Th Registrant's first dated of use of SLIMMING FACTORS on a nutritional product was later, i.e. May 12, 2002.Exhibit "H" and ¶ 9, Kleinsmith Decl.

Therefore, the Petitioner has priority.

##### D. Registration No. 2,740,269 Must be Cancelled

Where there is no issue of material fact concerning likelihood of confusion and where the Petitioner has priority, as here, Reg. No. 2,740,269 must be cancelled.

McCarthy on Trademarks, § 16:4, @ 16-6 makes this clear:

...the first to use a designation as a mark in the sale of goods or services is the "owner".

V. CONCLUSION

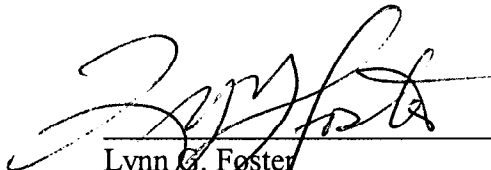
Where, as here, the Registrant concedes likelihood of confusion and does not have priority, Summary Judgment in favor of the Petitioner on both priority, likelihood of confusion and cancellation of Reg. No. 2,740,269 is appropriate and courteously invited.

VI. THIS PROCEEDING SHOULD BE STAYED

Pursuant to § 528.03 Trademark Trial and Appeal Board Manual of Procedure, this Cancellation Proceeding should be stayed pending a decision by the TTAB on this Motion for Summary Judgment.

DATED this 11<sup>th</sup> day of August, 2004.

Respectfully Submitted,

  
\_\_\_\_\_  
Lynn G. Foster  
Attorney for the Applicant

602 East 300 South  
Salt Lake City, UT 84102  
Telephone: (801) 364-5633

Lynn G. Foster (1105)  
LYNN G. FOSTER L.C.  
602 East 300 South  
Salt Lake City, UT 84102  
Telephone: (801) 364-5633  
Facsimile: (801) 355-8938



08-16-2004

U.S. Patent &amp; TMOfo/TM Mail Rpt Dt. #22

---

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
TRADEMARK TRIAL AND APPEAL BOARD

---

TPK Pharmaceutical, L.L.C.,

Petitioner,

vs.

Clientele, Inc.,

Respondent.

Cancellation No. 92042537

MAIL STOP TTAB NO FEE  
Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3513

DECLARATION OF ANTHONY KLEINSMITH

I, Anthony Kleinsmith, declare as follows:

1. I am a citizen of the United States of America and a resident of the State of Utah.
2. I am over 21 years of age, competent to testify and have personal knowledge as to the testimony presented herein.

3. The Petitioner, TPK Pharmaceutical, L.L.C. (TPK and Petitioner), and ITG, Inc. (ITG) are related companies in the field of nutritional and dietary supplements. IMMUNE TREE is a house mark of ITG registered in the United States Patent and Trademark Office (Reg. No. 2,415,620, copy attached as Exhibit "A").

4. I am the manager of TPK and the president of ITG and have been at all times relevant.

5. One of the supplements is called SLIM FACTORS. A copy of a label attached to containers of the goods is attached as Exhibit "B."

6. Relevant SLIM FACTORS literature is attached as Exhibit "C."

7. The mark SLIM FACTORS was first used on the nutrition product on March 26, 2002 (Exhibit "D") and has been continuously used thereafter (Exhibit "E"). Representative invoices are attached as Exhibit "F."

8. On February 19, 2003, the Petitioner filed U.S. Trademark Application Serial No. 76/492,358 for registration of SLIM FACTORS based upon Petitioner's first date of use, i.e. March 26, 2002. A copy of the Application is attached as Exhibit "G."

9. Based upon a use date of May 12, 2002, the Registrant, Clientele, Inc., filed U.S. Trademark Application Serial No. 76/459,995 on October 21, 2002, for SLIM FACTORS which matured into U.S. Reg. No. 2,740,269 copy attached as Exhibit "H."



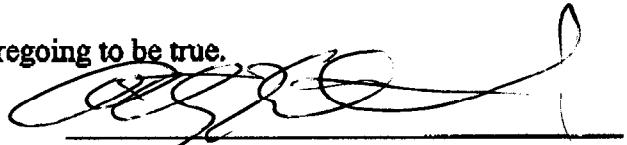
10. The Petitioner has priority in its use date (March 26, 2002) over the use date May 12, 2002 of the Registrant. Therefore, Reg. No. 2,740,269 should be cancelled.

11. In the course of discovery, the Registrant has failed to provide any evidence of a use date earlier than May 12, 2002, for SLIM FACTORS on the Registrant's nutritional goods in the ordinary course of Registrant's business and trade.

12. In Petitioner's pending Trademark Application Serial No. 76/495,358 for SLIM FACTORS, the Examining Attorney has held there is a likelihood of public confusion. Exhibit "I."

13. The Registrant does not challenge the determination of the Examining Attorney that there is a likelihood of public confusion. Exhibit "J."

Under penalty of perjury, I swear the foregoing to be true.

  
\_\_\_\_\_  
ANTHONY KLEINSMITH

8/10/04  
\_\_\_\_\_  
DATE

EXHIBIT “A”

Int. Cl.: 5

Prior U.S. Cls.: 6, 18, 44, 46, 51 and 52

Reg. No. 2,415,620

**United States Patent and Trademark Office**

Registered Dec. 26, 2000

**TRADEMARK  
PRINCIPAL REGISTER**

**IMMUNE-TREE**

TPK PHARMACEUTICAL, L.L.C (NEVADA LIMITED  
LIABILITY COMPANY)  
1177 SOUTH 1680 WEST  
OREM, UT 84058

FIRST USE 9-24-1998; IN COMMERCE 9-24-1998.

SER. NO. 75-849,482, FILED 11-12-1999.

JEAN IM, EXAMINING ATTORNEY

FOR: DIETARY SUPPLEMENT COMPRISED OF  
BOVINE COLOSTRUM, IN CLASS 5 (U.S. CLS. 6,  
18, 44, 46, 51 AND 52).

## EXHIBIT “B”

IgF-1 – Directs metabolic processes to help the body:

- Burn fat
- Balance blood sugar
- Build lean muscle
- Work with Leptin to inhibit fat synthesis

Leptin (from the Greek word, Leptos – meaning thin) Orchestrates the use of fats to help the body:

- Accelerate fat breakdown
- Control appetite and sweet cravings
- Promote fat loss
- Regulate pituitary and thyroid functions
- Influence fat cell size

Co-factors – Several co-factors work with IgF-1 and Leptin to help the body:

- Stimulate fat burning thermogenesis
- Curb excessive appetite and cravings
- Reduce insulin resistance
- Inhibit caloric storage as fat
- Neutralize starch and carbs

**MORE MUSCLE - LESS FAT - LEANER BODY**

\* These statements have not been evaluated by the Food and Drug Administration. This product is not intended to diagnose, treat, cure, or prevent any disease.



**Suggested use:** 3 capsules twice daily on an empty stomach with 8 oz. of water. **Advanced use:** 4 Capsules twice daily. **Maintenance equals 1/2** *Dr. Barry Ross* dosage.



### Supplement Facts

Serving size: 6 Capsules  
Servings per container: 30

Amount per serving	% Daily Value
Leptin & IgF-1 rich Colostrum	2750 mg **
Garcinia Cambogia (standardized for 60% HCA)(fruit)	750mg **
Citrus Aurantium L.	250mg **
Phaseolus vulgaris	205mg **
Chromium (as Chromium Polynicotinate)	400mcg **
Green Tea Extract (standardized for 20% polyphenols)(leaf)	600mg **

\* Percent daily values are based on 2000 calorie diet  
\*\* Daily Value not established

Distributed by ITG, Inc  
Orem, Utah 84058  
www.slimfactors.com

1-888-484-8671



## EXHIBIT “C”

# Weight Loss vs. Inch Loss

It's not how *much* you weigh, but *what* your weight is made of!

When it comes right down to it, most of us would much rather be trimmer *and* have others notice, (inch loss) than be able to quote the exact number of pounds we've dropped, (weight loss). We would rather see and feel the difference than keep track of how much the scales fluctuate. And that's the way the body prefers it, too. Dieting (which actually causes the body to "hold on" to weight) is far less effective than focusing on *metabolic balance*, which usually results in more energy, a greater muscle mass and a few less inches.

As metabolic balance is achieved, it is quite common to notice a loss of inches rather than a loss of weight (although weight often drops too). This is because muscle weighs more than fat. With The Slim Factors™ Program, the fat is burned first. And, with a minimum of exercise, the fat is replaced by lean muscle.

You're going to  
love the new you!

## The Program

1. \*Take Slim Factors™ capsules (3, twice a day). Slim Factors™ offers 2 basic formulas.
2. Replace at least one meal a day with Slim Factors™ accelerator meal replacement shake.
3. Drink plenty of water and exercise moderately at least 3 times a week.

Immune-Free™

FACTORS™

A Totally

NEW Approach

to INCH loss!



Are you ready for a  
new wardrobe?

## EXHIBIT “D”



Stock ID	UoM	Loc	Customer ID	Order ID Inv. ID	Ord Date Inv Date	Qty Ordered Qty Shipped	Sale Amount Cost of Sale	Profit \$ Margin %
				7112	03/26/02	6.000	0.00	100.000
	EA 1		DC Natural Foods	8106	03/25/02	6.000	120.00	120.00
			Slim Factors Capsules	7122	03/26/02	6.000	0.00	100.000
	EA 1		Health Food Cntr/Oklahoma	8112	03/25/02	12.000	240.00	240.00
			Slim Factors Capsules	7128	03/26/02	12.000	0.00	100.000
	EA 1		Natures Way/Greensburg	8126	03/26/02	12.000	240.00	240.00
			Slim Factors Capsules	7142	03/27/02	12.000	0.00	100.000
	EA 1		Vita Smart Nutrition Ctr.	8130	03/26/02	12.000	240.00	240.00
			Slim Factors Capsules	7146	03/27/02	12.000	0.00	100.000

Bob

looks like our first order shipped  
out on 3/26/02.

if you need something else  
let me know

Chardeell

## EXHIBIT “E”

ITG SALES (Qty.)																		
Item #	Item Name	Nov-02	Dec-02	Jan-03	Feb-03	Mar-03	Apr-03	May-03	Jun-03	Jul-03	Aug-03	Sep-03	Oct-03	Nov-03	Dec-03	Total Sales 2003	Jan-04	Feb-04
1016	Slim Factor Capsules	2235	2117	3044	5130	2052	2629	2296	2000	1136	2204	1587	1598	760	884	25,320	854	747

		Updated to 5May04
Mar-04	Apr-04	May-04
980	914	60

## EXHIBIT “F”

Customer ID..... vita0035  
Customer Name..... Vitamins and More  
Order ID..... 9864  
Ref.Order ID.....

Type/Status..... N / I  
S/O Date..... 05/14/02  
Invoice ID..... 8604  
Invoice Date..... 05/15/02

[----- Bill To -----] | [----- Ship To -----]  
Name..... Vitamins and More                      Vitamins and More  
Name.....  
Address..... 1501 Rimpoau Ave                      1501 Rimpoau Ave  
Address..... STE B-104                      STE B-104  
City/St..... Corona                      CA                      Corona                      CA  
Zip..... 92880                      92880

P.O. Number..... Larry                      Payment Terms..... 04  
Ship Via..... UPS Ground                      Tax Code 1.....  
F.O.B..... Shipping Point                      Tax Code 2.....  
Ship Date: Request..... 00/00/00                      Tax Code 3.....  
Ship Date: Actual..... 00/00/00                      GL A/R Acct..... 12000-01  
Sales rep..... SER                      I/C Price Code..... 1  
A/R Description.....                      I/C Location..... 1  
Comments..... LH

Itm	Qty Ordered	Stock ID Code	Line Item Description	UoM	Loc
	Qty Shipped	Unit Price	Discnt: %-Amnt	Extension	Tax
				GL Acct	No.
1	12.000	SLIM1001	Slim Factors Capsules	EA	1
	12.000	25.0000	20.0	60.00	240.00 N 50100-01
2	25.000	ART0022	Colostrum in General	EA	1
	25.000	0.0000	0.0	0.00	0.00 N 50100-01
3	25.000	BRO0004	Brochure Slim Factors	EA	1
	25.000	0.0000	0.0	0.00	0.00 N 50100-01
4	25.000	art0083	DP Slim Factors/Leptin Factors	EA	1
	25.000	0.0000	0.0	0.00	0.00 N 50100-01
5	1.000	FREE1001	Free Bottle to offset Shipping	EA	1
	1.000	0.0000	0.0	0.00	0.00 N 50100-01
6	50.000	NEW0001	Colostrum Option Newspaper	EA	1
	50.000	0.0000	0.0	0.00	0.00 N 50100-01
7	1.000	APP0001	Credit Application	EA	1
	1.000	0.0000	0.0	0.00	0.00 N 50100-01

Invoice Sub-total ( 7 line items).....	240.00	Tax	GL Account No.
[ SHIPPING ] .....	8.00	N	50500-01
Total Non-Taxable Sales.....	248.00	-----	Applied Payments -----
Total Taxable Sales.....	0.00	Code	Reference                      Amount
Tax Applied (code 1).....	0.00	-----	-----
Tax Applied (code 2).....	0.00	1	0.00
Tax Applied (code 3).....	0.00	2	0.00
Invoice Total.....	248.00	Balance:	248.00



**Immune-Tree**  
1163 South 1680 West  
Orem, UT 84058  
Phone: (888) 484-8671  
Fax: (801) 434-8248

## ORDER CONFIRMATION

Sales Order No. R0013658  
Order Type SO Credit Card  
Customer ID LIV10007

BILL TO:	SHIP TO:
Living Foods Pantry 1921 W. Grand Ave. Waukegan, IL 60085	Living Foods Pantry 1921 W. Grand Ave. Waukegan, IL 60085

Notes:

PAGE 1

F.O.B. POINT		SHIP VIA		ORDERED BY		CUSTOMER P.O. NO.	
Destination		UPS Ground					
ORDER DATE		TERMS		SALES PERSON		CONTRACT NUMBER	
5/4/2004		CREDIT CARD		PAM JOHNSON & ASSOCIATES			
PART NUMBER		QUANTITY		UNITS		UNIT PRICE	
						DISC %	
						EXTENDED PRICE	

1034	5.0000	EA	17.0000	1.00	84.15
ITG- Slim Accel. Chocolate (Small)					
Notes:					
1035	1.0000	EA	17.0000	1.00	16.83
ITG- Slim Accel. Vanilla (Small)					
Notes:					
1016	6.0000	EA	25.0000	1.00	148.50
ITG-Slim Factor Capsules					
Notes:					
1047	2.0000	EA	0.0000	0.00	
ITG- Slim Accel. One Shot Chocolate					
Notes:					
1048	2.0000	EA	0.0000	0.00	
ITG- Slim Accel. One Shot Cremesicle					
Notes:					
1110	2.0000	EA	0.0000	0.00	
ITG- Slim Accel. One Shot Vanilla					
Notes:					

9.07

258.55

Continued

## EXHIBIT “G”



## **TRADEMARK APPLICATION**

Mark: SLIM FACTORS

International Class: 5

TO THE COMMISSIONER OF PATENTS AND TRADEMARKS:

PTK PHARMACEUTICAL, L.L.C. (dba Immune-Tree) the Applicant, is a Limited Liability Company duly organized and existing under the laws of the State of Nevada, having a place of business at 1163 South 1680 West, Orem, Utah 84058.

The above-identified Applicant has adopted and is using the mark shown in the accompanying drawing for a nutritional product comprising a nutritional supplement and requests that said mark be registered in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946.

The mark was first used on the goods on March 26, 2002; was first used on the goods in interstate commerce on March 26, 2002; and is now in said use in such commerce.

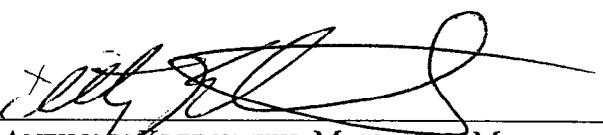
The mark is used in association with the goods and one specimen showing the mark as actually used are presented herewith.

Applicant appoints the law firm of LYNN G. FOSTER, L.C., 602 East 300 South, Salt lake City, Utah 84102, telephone number (801) 364-5633 and facsimile number (801) 35-8938, comprised of attorney Lynn G. Foster, to prosecute this application and transact all business in the Patent and Trademark Office in connection with this application, and to receive the Certificate of Registration.

## DECLARATION

The undersigned being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. §1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that he is properly authorized to execute this application on behalf of the Applicant; he believes the Applicant to be the owner of the mark sought to be registered, or, if the application is being filed under 15 U.S.C. §1051(b), he believes the Applicant to be entitled to use such mark in commerce; to the best of his knowledge and belief no other person, firm, corporation, or association has the right to use the above-identified mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods or services of such other person, to cause confusion, or to cause mistake, or to deceive; and all statements made of his own knowledge are true and all statements made on information and belief are believed to be true.

TPK PHARMACEUTICAL, L.L.C.

By:   
ANTHONY KLEINSMITH, MANAGING MEMBER

✓ 2/12/03  
DATE

**DRAWING**

**APPLICANT:** TPK PHARMACEUTICAL, L.L.C.

**ADDRESS:** 1163 South 1680 West  
Orem, Utah 84058

**DATE OF FIRST USE:** March 26, 2002

**DATE OF FIRST USE IN COMMERCE:** March 26, 2002

**GOODS:** NUTRITIONAL SUPPLEMENT

**Slim**  
**FACTORS**

## EXHIBIT “H”

Int. Cl.: 5

Prior U.S. Cls.: 6, 18, 44, 46, 51 and 52

**United States Patent and Trademark Office**

**Reg. No. 2,740,269**

Registered July 22, 2003

**TRADEMARK  
PRINCIPAL REGISTER**

**SLIMMING FACTORS**

CLIENTELE, INC. (FLORIDA CORPORATION)  
14101 NW 4TH STREET  
SUNRISE, FL 33325

FOR: PHARMACEUTICALS, NAMELY, DIET-  
ARY AND NUTRITIONAL SUPPLEMENTS AS A  
BEVERAGE ADDITIVE IN THE FORM OF AN  
EFFERVESCENT TABLET, IN CLASS 5 (U.S. CLS. 6,  
18, 44, 46, 51 AND 52).

FIRST USE 5-12-2002; IN COMMERCE 5-12-2002.

NO CLAIM IS MADE TO THE EXCLUSIVE  
RIGHT TO USE "FACTORS", APART FROM THE  
MARK AS SHOWN.

SER. NO. 76-459,995, FILED 10-21-2002.

JEFF DEFORD, EXAMINING ATTORNEY

## EXHIBIT “I”

# UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 76/492358

APPLICANT: PTK PHARMACEUTICAL, L.L.C.

**CORRESPONDENT ADDRESS:**

LYNN G. FOSTER  
LYNN G FOSTER L C  
602 E 300 S  
SALT LAKE CITY UT 84102-2104

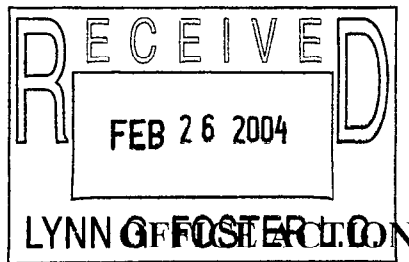
**RETURN ADDRESS:**

Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3514  
**ecom115@uspto.gov**

MARK: SLIM FACTORS

CORRESPONDENT'S REFERENCE/DOCKET NO: 8609

CORRESPONDENT EMAIL ADDRESS:



Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

**TO AVOID ABANDONMENT, WE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF OUR MAILING OR E-MAILING DATE.**

RE: Serial Number 76/492358

This letter responds to the applicant's communication filed on October 6, 2003. The examining attorney previously noted Application Serial No. 76/459995. In its communication, the applicant has not responded to the substantive issues raised but instead requests suspension based on the fact that the applicant had entered into negotiations with the owner of the noted prior pending application. The Office will generally not suspend an application in order to permit parties time to negotiate a consent agreement. TMEP §716.02. Because the referenced application has matured into a registration, registration is refused as set forth below. The examining attorney notes that cancellation proceeding number 92042537 has been instituted. Therefore, upon the applicant's response to this Office action, this application will be suspended pending resolution of that proceeding.

**Refusal Under Section 2(d)**

The examining attorney refuses registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d), because the applicant's mark, when used on or in connection with the identified goods/services, so resembles the mark in U.S. Registration No. as to be likely to cause confusion, to cause mistake, or to deceive. TMEP §§1207.01 *et seq.* See the enclosed registration.

The examining attorney must analyze each case in two steps to determine whether there is a likelihood of confusion. First, the examining attorney must look at the marks themselves for similarities in appearance, sound, connotation and commercial impression. *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). Second, the examining attorney must compare the goods or services to determine if they are related or if the activities surrounding their marketing are such that confusion as to origin is likely. *In re August Storck KG*, 218 USPQ 823 (TTAB 1983); *In re International Telephone and Telegraph Corp.*, 197 USPQ 910 (TTAB 1978); *Guardian Products Co., v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978). TMEP §§1207.01 *et seq.*

The applicant seeks to register the mark SLIM FACTORS for “nutritional supplement” and as “a nutritional product comprising a nutritional supplement.”

The registrant has registered the mark SLIMMING FACTORS for “pharmaceuticals, namely, dietary and nutritional supplements as a beverage additive in the form of an effervescent tablet.”

The marks are highly similar in sound, appearance and meaning since both are comprised of the term FACTORS immediately preceded by SLIM or SLIMMING. Both marks create the same commercial impression of a factor that will cause one to become slimmer.

The goods are legally identical since the applicant’s identification of the goods necessarily includes the registrant’s more particularly defined nutritional supplements.

The examining attorney must resolve any doubt as to the issue of likelihood of confusion in favor of the registrant and against the applicant who has a legal duty to select a mark which is totally dissimilar to trademarks already being used. *Burroughs Wellcome Co. v. Warner-Lambert Co.*, 203 USPQ 191 (TTAB 1979).

Although the examining attorney has refused registration, the applicant may respond to the refusal to register by submitting evidence and arguments in support of registration. If the applicant chooses to respond to the refusal to register, the applicant must also respond to the following issues.

#### **Identification of the Goods**

In its response, the applicant fails to address the requirement for an acceptable identification of the goods. Accordingly, the requirement is continued and maintained. The applicant has identified the goods as “nutritional supplements” and as “a nutritional product comprising a nutritional supplement” within the drawing page and application. The wording is thus, unclear and unacceptable as indefinite.

The applicant must amend the identification to specify the commercial name of the goods. If there is no common commercial name for the product, the applicant must describe the product and its intended uses. TMEP §1402.01. The applicant may amend the identification of the goods to read as “**nutritional supplements**,” if accurate.

#### **Disclaimer**

The applicant must disclaim the descriptive wording “FACTORS” apart from the mark as shown. Trademark Act Section 6, 15 U.S.C. §1056; TMEP §§1213 and 1213.03(a). In its response, the



applicant fails to address the requirement for a disclaimer of the term FACTORS. Accordingly, the requirement is continued and maintained. The examining attorney relies on the following dictionary definition of the term FACTOR.

## fac·tor

**fac·tor** (fàk'ter) *noun*

1. One that actively contributes to an accomplishment, a result, or a process: "*Surprise is the greatest factor in war*" (Tom Clancy). See synonyms at element.
2. **a.** One who acts for someone else; an agent. **b.** A person or firm that accepts accounts receivable as security for short-term loans.
3. *Mathematics.* One of two or more quantities that divides a given quantity without a remainder: *2 and 3 are factors of 6; a and b are factors of ab.*
4. A quantity by which a stated quantity is multiplied or divided, so as to indicate an increase or decrease in a measurement: *The rate increased by a factor of ten.*
5. A gene. No longer in technical usage.
6. *Physiology.* A substance that functions in a specific biochemical reaction or bodily process, such as blood coagulation.

*verb, transitive*

**fac·tored, fac·tor·ing, fac·tors**

To determine or indicate explicitly the factors of.

— *phrasal verb.*

**factor in**

To figure in: *We factored sick days and vacations in when we prepared the work schedule.*

[Middle English *factour*, perpetrator, agent, from Old French *facteur*, from Latin *factor*, maker, from *facere*, to make.]

— **fac'tor·a·ble** *adjective*

— **fac'tor·ship** *noun*<sup>1</sup>

### **Mark in Drawing Differs from Mark in Specimen**

In its response, the applicant fails to address the requirement that the mark in the drawing display the mark as shown in the specimen of use. Accordingly, the requirement is continued and maintained. The drawing displays the mark as SLIM FACTORS. However, this differs from the display of the mark on the specimen, where it appears as SLIM FACTORS in a different font. The applicant must either:

- (1) submit a new drawing of the mark that agrees with the specimen; or
- (2) submit a substitute specimen that shows use of the mark shown in the drawing.

---

<sup>1</sup> *The American Heritage® Dictionary of the English Language, Third Edition* copyright © 1992 by Houghton Mifflin Company. Electronic version licensed from INSO Corporation; further reproduction and distribution restricted in accordance with the Copyright Law of the United States. All rights reserved.

37 C.F.R. §2.51; TMEP §§807.14 and 807.14(a)(i). The applicant may not amend the drawing if the amendment would materially alter the character of the mark. 37 C.F.R. §2.72(a); TMEP §807.14(a).

If a substitute specimen is submitted, the applicant must verify, with an affidavit or a declaration under 37 C.F.R. §2.20, that the substitute specimen was in use in commerce at least as early as the filing date of the application. 37 C.F.R. §§2.59(a) and 2.72(a); TMEP §904.09.

If the applicant has any questions or needs assistance in responding to this Office action, please telephone the assigned examining attorney.

/tfletch/  
Tracy L. Fletcher  
Examining Attorney  
Law Office 115  
Phone: (703) 308-9115 ext. 205  
Facsimile: (703) 872-9875

**How to respond to this Office Action:**

To respond formally using the Office's Trademark Electronic Application System (TEAS), visit <http://www.uspto.gov/teas/index.html> and follow the instructions.

To respond formally via E-mail, visit <http://www.uspto.gov/web/trademarks/tmelecresp.htm> and follow the instructions.

To respond formally via regular mail, your response should be sent to the mailing Return Address listed above and include the serial number, law office and examining attorney's name on the upper right corner of each page of your response.

To check the status of your application at any time, visit the Office's Trademark Applications and Registrations Retrieval (TARR) system at <http://tarr.uspto.gov/>

For general and other useful information about trademarks, you are encouraged to visit the Office's web site at <http://www.uspto.gov/main/trademarks.htm>

**FOR INQUIRIES OR QUESTIONS ABOUT THIS OFFICE ACTION, PLEASE CONTACT THE ASSIGNED EXAMINING ATTORNEY.**

\*\*\* User: tfletcher \*\* Serial Number: 76459995 \* 2/18/04 4:37:17 PM \*\*  
[Typed Drawing]

Mark

SLIMMING FACTORS

Goods and Services

IC 005. US 006 018 044 046 051 052. G & S: Pharmaceuticals, namely,  
Dietary and Nutritional Supplements as a beverage additive in the form of  
an effervescent tablet. FIRST USE: 20020512. FIRST USE IN COMMERCE:  
20020512

Mark Drawing Code

(1) TYPED DRAWING

Serial Number

76459995

Filing Date

October 21, 2002

Current Filing Basis

1A

Original Filing Basis

1A

Publication for Opposition Date

April 29, 2003

Registration Number

2740269

Registration Date

July 22, 2003

Owner Name and Address

(REGISTRANT) Clientele, Inc. CORPORATION FLORIDA 14101 NW 4th Street  
Sunrise FLORIDA 33325

Disclaimer Statement

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "FACTORS" APART FROM THE  
MARK AS SHOWN

Type of Mark

TRADEMARK

Register

PRINCIPAL

Live Dead Indicator

LIVE

Attorney of Record

Jason K. Psaltides

\*\*\* Search: 1 \*\*\* Document Number: 1 \*\*\*

## EXHIBIT “J”

LAW OFFICES  
**LYNN G. FOSTER L.C.**

A LIMITED LIABILITY COMPANY

PATENTS  
TRADEMARKS  
COPYRIGHTS  
TRADE SECRETS  
UNFAIR COMPETITION  
RELATED LITIGATION

602 EAST 300 SOUTH  
SALT LAKE CITY, UTAH 84102  
TELEPHONE: (801) 364-5633  
FACSIMILE: (801) 355-8938  
E-MAIL: foster@fosterpatlaw.com

LYNN G. FOSTER

REG. PROF. ENGINEER  
ATTORNEY AT LAW  
PATENT ATTORNEY

June 19, 2003

Jason K. Psaltides  
C/O CLIENTELE, INC.  
14101 N.W. 4<sup>th</sup> Street  
Sunrise, Florida 33325

Re: U.S. Trademark Application for SLIM FACTORS; My File 8609

Dear Mr. Psaltides:

I understand that you are responsible for the trademark matters of Clientele, Inc.

I am writing to you concerning an apparent conflict between an application filed on behalf of your client, Clientele, Inc., for the mark SLIMMING FACTORS, U.S. trademark application Serial No. 76/459,995, filed October 21, 2002 for nutritional supplements. My client just learned of this application. Your client's first date of use was May 12, 2002.

On February 19, 2003, I filed on behalf of my client, TPK PHARMACEUTICAL L.L.C. a trademark application for SLIM FACTORS in International Class 5 for a nutritional supplement. This mark was used by my client for the first time March 26, 2002.

Rather than get into the details and costs of a trademark cancellation, I am writing to inquire as to whether your client would be willing to discontinue voluntarily the use of SLIMMING FACTORS on the ground and for the reason that my client is first in time and, therefore, first in right and confusion is likely.

I look forward to hearing from you in the near term.

Cordially,

Lynn G. Foster  
For the Firm

LGF/dlh

LAW OFFICES  
**LYNN G. FOSTER L.C.**  
A LIMITED LIABILITY COMPANY

PATENTS  
TRADEMARKS  
COPYRIGHTS  
TRADE SECRETS  
UNFAIR COMPETITION  
RELATED LITIGATION

602 EAST 300 SOUTH  
SALT LAKE CITY, UTAH 84102  
TELEPHONE: (801) 364-5633  
FACSIMILE: (801) 355-8938  
E-MAIL: foster@fosterpatlaw.com

LYNN G. FOSTER

REG. PROF. ENGINEER  
ATTORNEY AT LAW  
PATENT ATTORNEY

October 1, 2003

Jason K. Psaltides  
c/o Clientele, Inc.  
14101 N.W. 4<sup>th</sup> Street  
Sunrise, FL 33325

Dear Mr. Psaltides:

Some time ago I forwarded to you a letter, a copy enclosed, asking for certain information regarding your client's mark SLIMMING FACTORS, as it may relate to my client's mark SLIM FACTORS. You have not yet responded and I would appreciate hearing from you on an expedited basis. It is our hope that we can come to an understanding of the relevant factors in this matters and resolve the issue using common sense superimposed upon the controlling case law. We are hopeful that you will not go forward silently to obtain registration of SLIMMING FACTORS, thereby forcing us to file for cancellation.

May I hear from you soon?

Cordially,

Lynn G. Foster

LGF/alm

cc: O. Robert Meredith

\\2003\ImmuneTree\8609.Psaltides.Ltr.100103.wpd

Lynn G. Foster (1105)  
LYNN G. FOSTER, L.C.  
602 East 300 South  
Salt Lake City, UT 84102  
Telephone: (801) 364-5633  
Facsimile: (801) 355-8938

---

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
TRADEMARK TRIAL AND APPEAL BOARD

---

TPK Pharmaceutical, L.L.C.,

Petitioner,

vs.

Clientele, Inc.,

Respondent.

Cancellation No. 92042537

Mail Stop TTAB- No Fee  
Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3513

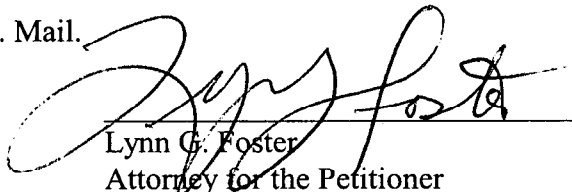
CERTIFICATE OF SERVICE

I certify that on August 11<sup>th</sup>, 2004, a true and correct copy of PETITIONER'S MOTION FOR SUMMARY JUDGMENT AND MEMORANDUM IN SUPPORT THEREOF and the DECLARATION of ANTHONY KLEINSMITH were served in the manner indicated below to the following:

Jason K. Psaltides  
Clientele, Inc.  
14101 N.W. 4<sup>th</sup> Street  
Sunrise, FL 33325

  X   U.S. Mail  
       Overnight Delivery  
       Facsimile  
       Hand-delivery

, with the originals dispatched to the TTAB, Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-35156, via U.S. Mail.

  
\_\_\_\_\_  
Lynn G. Foster  
Attorney for the Petitioner